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EXAMINER

PICKETT, JOHN G

| ART UNIT | PAPER NUMBER |
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3728

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,459

Applicant(s)

KAWAGUCHI ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-11 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6 and 8-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 7 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office action acknowledges the applicant's Amendment submitted 14 October 2004. Claims 1 and 3-11 are pending in the application. Claim 7 is withdrawn from further consideration as being directed to a non-elected invention.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 1, 3, 5, 6, 8, 9, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stone (US 5,314,114) in view of Stone (US 3,963,173), Giblin et al (US 5,320,279), Gottfreid (US 5,348,147), and Pritchard et al (GB 2 264 287 A, provided by applicant).

Regarding claim 1, Stone '114 discloses a paper container (10) having a hexahedral configuration (see Figure 4) and comprising a container main body (26); a lid member (28) attached to a back side edge part (29) of an upper end open surface of the container main body and having an upper surface lid part (12), a front surface lid part (57), and a pair of side lid parts (as shown, Figure 4); an inner carton part (40, 42, 44) with concave cutout part (50) formed on a front board (42); and severance guide line (24) extending obliquely downward along a pair of side boards and extending along the front board under the cutout part. The container of Stone '114 is sized as claimed

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by the applicant and is capable of storing an agglomerated detergent (see for example, Col. 1, line 29).

Stone '114 does not disclose the severance guide line extending from opposite ends of the connecting ridge line or a concave cutout part completely removed from the front board of the inner carton part.

Stone '173 discloses a container (Figure 19) with an inner carton part (184) having a concave cutout part (186) completely removed from front board (184) and severance guide line (222, 206) extending from opposite ends of the connecting ridge line (as shown, Figure 19). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Stone '114 with a lid and cutout structure as taught by Stone '173 in order to provide ready access to the contents (see for example, Stone '173, Col. 1, ll. 41-45).

Stone '114-Stone '173 does not disclose an inner carton part being mounted on and separate from the container.

Both Giblin et al and Pritchard et al disclose a container with an inner carton part that may be separate from the container (Giblin, Col. 2, ll. 18-20; Pritchard, Figures 4 and 7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the container of Stone '114-Stone '173 with an inner carton part that is separate as taught by Giblin et al or Pritchard et al in order to allow for the printing of separate material on the inner carton part. It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman, 168 USPQ 177, 179.

As to the upper half of the front board being above the severance guide line, both Pritchard et al and Gottfreid disclose that it was desirable in the art at the time the invention was made to have deep openings above the severance guide line (see Pritchard, Figure 1; Gottfreid Figure 7). It would have been an obvious matter of design choice, dependent upon the desired articles to be contained, to provide the container of Stone-Stone-Giblin-Pritchard with a severance guide line positioned such that the upper half of the front board is above the severance guide line, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 3, the container of Stone-Stone-Giblin-Gottfreid-Pritchard discloses lock parts (Stone '173, 188, 190).

As to claim 5, the container of Stone-Stone-Giblin-Gottfreid-Pritchard is capable of storing a packaged detergent; such a limitation constitutes an intended use.

As to claim 6, the container of Stone-Stone-Giblin-Gottfreid-Pritchard discloses a container formed of a moisture proof material (Giblin, Col. 2, ll. 25-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include this feature in the container of Stone-Stone-Giblin-Gottfreid-Pritchard to protect the packaged detergent during storage. The container of Stone-Stone-Giblin-Gottfreid-Pritchard is capable of storing a sheet-like detergent; such a limitation constitutes an intended use.

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As to claim 8, the container of Stone-Stone-Giblin-Gottfreid-Pritchard discloses a unitary front board (Stone '173, 184).

As to claim 9, the container of Stone-Stone-Giblin-Gottfreid-Pritchard discloses a separate inner carton part (see for example, Giblin et al, Col. 2, ll. 18-20).

As to claim 10, the container of Stone-Stone-Giblin-Gottfreid-Pritchard is capable of storing a sheet-like detergent contained in a multi-layered manner; such a limitation constitutes an intended use.

As to claim 11, the container of Stone-Stone-Giblin-Gottfreid-Pritchard discloses an inner bottom board (Pritchard, 24).

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stone-Stone-Giblin-Gottfreid-Pritchard as applied to claim 1 above, and further in view of Wood et al (US 5,985,772).

The container of Stone-Stone-Giblin-Gottfreid-Pritchard, as applied to claim 1 above, meets all limitations claimed by the applicant except for the paper material formed of a paper baser material, a printed layer, an outer colored film, and an inner film.

Wood et al discloses a packaging material comprising a paper base material (240), a printed layer (220), an outer colored film (210), and an inner film (210). The outer film (210) and inner film (210) of Wood et al consists of an aqueous borne acrylic coating having a natural color. The coatings can also be pigmented (Col. 8, ll. 16-18). It would have been obvious to one of ordinary skill in the art at the time the invention

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was made to fabricate the container of Stone-Stone-Giblin-Gottfreid-Pritchard with a packaging material as taught by Wood et al in order to protect the paper base material and printed matter from damage.

Response to Arguments

5. Applicant's arguments, see pages 7-9, filed 14 October 2004, with respect to the rejection(s) of claim(s) 1, 3, 5, 6, 8, 9, and 10 under 35 USC 103(a) have been fully considered and are persuasive. The examiner concedes that the Pritchard reference alone does not expressly disclose the depth of the cutout claimed. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art Gottfreid. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). The crux of the rejection is based upon the Stone-Stone combination. Giblin et al, Pritchard et al and Gottfreid are brought forth as evidence supporting the case law presented by the examiner for the "make separable" and "change in size" aspects required by the claim.

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7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion can be found in the prior art of record. Stone '173 specifically states in Col. 1, lines 41-45, "...these generally used containers have frequently been provided with a recess in the front of the container to provide ready access to the contents thereof." Making the inner portion separate and changing the size of the opening is well within the level of ordinary skill in the art.

8. In response to applicant's argument that the teachings cannot be made on the construction of the boxes as shown, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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Conclusion

9. As the examiner has revised his position on the reading of the prior art, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
22 December 2004


Mickey Yu
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Group 3700